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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/744,484   | 05/21/2001  | Horst Grafc          | HM-390PCT           | 5641             |
| 7590   | 10/13/2006  |                      | EXAMINER            |                  |
| Friedrich Kueffner<br>317 Madison Avenue<br>New York, NY 10173 |             |                      | PRONE, JASON D      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3724                |                  |

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/744,484             | GRAFE ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Jason Prone            | 3724                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 August 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 6, and 7 are objected to because of the following informalities: The reference numerals are supposed to be in the claims as a guide to make reading the claim easier, however, in this case the reference numerals make the claims more confusing. For example line 16 of claim 6 discloses the term "the holding element (6)" which is a singular term. Line 15 of claim 7, discloses the exact same singular term "the holding element (6, 6')" followed by two reference numerals. How can this term be singular but represent two separate structures. Also, the numerals are not consistently used throughout each claim, for example lines 8-9 of claim 1 features the term "blade holders" without a reference numeral. It is recommended that all of the reference numerals be removed from the claims. Also, on line 18 of claim 7, the phrase "the rolling line" should be replaced with the "rolling or transport line". It is noted that claims 1-8 lack consistency throughout. All of the claims must be reviewed and all like terms that are called by different names must be changed so they are called the same name. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is written in such a way that the examiner

cannot understand the various functional limitations and if there is even structure. It is not clear how things work and, as the work piece progresses, the structure is unclear regarding the various "overlaps" of the blades and holders. Basically each of these claims (claim 1 more than the others) is a huge run-on sentence that is replete with grammatical and idiomatic errors that make it impossible to determine the scope of the claim. The claims are still replete with antecedent basis issues (see below).

4. The claims, especially claim 1, are indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

5. Claim 1 recites the limitations "blade holders" and "the side" on lines 5 and 9-10. There are insufficient antecedent basis for these limitations in the claim.

6. Claim 4 recites the limitation "the U-shaped open side" on line 2. The term U-shaped frame has been previously disclosed but the "side" has not. It is recommended that the phrase "the U-shaped open side of the frame" be replaced with "the U-shaped frame". There is insufficient antecedent basis for this limitation in the claim.

7. Claim 5 recites the limitations "the clamping element" and "the frame arms" on lines 2 and 4. There are insufficient antecedent basis for these limitations in the claim.

8. Claim 6 recites the limitations "the holding element", "the clamping element", and "the pressure plates" on lines 16, 18, and 22. The reference numeral (6) next to the holding element does not provide a proper antecedent basis for this term. For example, the phrase "the holding element" should be replaced with "at least one of said holding

elements" to make the term proper. There are insufficient antecedent basis for these limitations in the claim.

9. In regards to claim 6 line 19, the phrase "for overlapping them" is unclear. It is not clear what structure is being defined by the term "them". Basically applicant needs to replace the word "them" with the structures being overlapped.

10. Claim 7 recites the limitations "the holding element", "the free end", "the upper horizontal frame arm", "the lower frame arm", "the upper holding element", and "the aid" on lines 15, 16, 20, 21-22, and 23.

11. In regards to claims 7 line 18, the phrase "pivotal to both sides" is unclear. Two sides (drive side and rolling table side) are previously disclosed but it is unclear if the term "both sides" is referencing to the previously disclosed sides or two other sides. If this term is referring to drive side and rolling table side the term "both sides" should be replaced with "both the drive side and the rolling table side".

12. Claim 8 recites the limitations "the clamping element" and "the frame arms" on lines 15 and 16. There are insufficient antecedent basis for these limitations in the claim.

#### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-5 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by David (3,408,886).

In regards to claims 1 and 2, David discloses a device for exchanging shears (Figs. 3-5) in the cutting to length of strips on a rolling table (1), the shears (Column 3 lines 9-13 and 30,31) are arranged on a rail-guided (29) drive carriage (26) is movable by means of a drive transverse to the rolling line (Figs. 4 and 5), the shear comprise a U-shaped frame open toward the rolling line and closed at a drive side (Fig. 4), at the drive side holding elements (34,35) are provided that support the blade holders (30,31), and wherein the drive carriage is coupled to a movable part of the rolling table (Fig. 4).

In regards to claim 3, David discloses the drive carriage at the rolling table side receives at least one clamping element with actuating members (40).

In regards to claim 4, David discloses the u-shaped open side of the frame has a correlated therewith a clamping element (38) coupled with the holding element at the rolling table side (39).

In regards to claim 5, David discloses the clamping element (38) is provided with coupling elements (37) that couple with the holding elements of the frame arms (39).

#### ***Allowable Subject Matter***

15. Claims 6-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

#### ***Response to Arguments***

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., the shears are only introduced into the line when the strip needs to be separated transversely) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also, it appears these claims are a literal translation because there are so many basic English errors featured in the claims, especially claim 1. The examiner attempted to re-write claim 1 but could not decipher what was intended. For example, the phrase, from lines 6-10, "wherein the shears can be moved together with the blade holders and with the holding elements for the blade holders after each cut out of the rolling line to the side into a neutral waiting position". How can the shears be moved with and for the blade holders? Claim 1 is filled with these types of issues. Because of the condition of the claims, the scope of the claims cannot be determined.

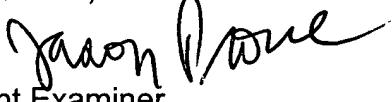
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 06, 2006

  
Patent Examiner  
Jason Prone  
Art Unit 3724  
T.C. 3700